IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

JOHN M. FLACK ET AL.

Group Art Unit: 3626

Examiner: Robert D. Rines

Serial No.: 10/036,202

Filed: December 27, 2001

For: COMPUTER-IMPLEMENTED METHOD AND SYSTEM FOR MANAGING PATIENT HEALTHCARE AND EVALUATING PATIENT KIDNEY FUNCTION

Attorney Docket No.: MTS 0102 PUS

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed October 1, 2008, please consider the following remarks:

REMARKS

Claims 10-18 are rejected under 35 U.S.C. 101.

The Examiner argues that

> The method steps presented in the body of [claim 10] fail to positively recite the use of a machine, article of manufacture, or a composition of matter in achieving the desired result. As presently constructed, the recited method steps can be accomplished purely by mental processing and are therefore not specifically enabled by another recognized statutory class of invention.
>
> While the Examiner recognizes that the preamble of claim 10 recites "a computer-implemented . . . method . . .", nominal recitation of another statutory class presented exclusively in the preamble of a process claim will not be awarded patentable weight when making determinations of subject matter eligible for patent under 35 U.S.C. 101. Accordingly, claim 10 is rejected because it is directed to non-statutory subject matter under 35 U.S.C. 101.

Office Action, October 1, 2008, p. 5.

The Federal Circuit, however, has stated that "[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re* Bernard L. Bilski and Rand A. Warsaw, 2007-1130, p. 10 (Fed. Cir., October 30, 2008) (emphasis in original). The Federal Circuit has also stated that

> The raw materials of many information-age processes . . . are electronic signals and electronically-manipulated data. And some so-called business methods, such as that claimed in the present case, involve the manipulation of even more abstract constructs such as legal obligations, organizational relationships,

and business risks. Which, if any, of these processes qualify as a transformation or reduction of an article into a different state or thing constituting patent-eligible subject matter?

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Our predecessor court's mixed result in Abele illustrates this point. There, we held unpatentable a broad independent claim reciting a process of graphically displaying variances of data from average values . . . . That claim did not specify any particular type or nature of data; nor did it specify how or from where the data was obtained or what the data represented . . . . In contrast, we held one of Abele's dependent claims to be drawn to patent-eligible subject matter where it specified that "said data is X-ray attenuation data produced in a two dimensional field by a computed tomography scanner" . . . . This data clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible.

In re Bilski, 2007-1130, p. 10 (Fed. Cir., October 30, 2008).

Claim 10 provides

A computer-implemented patient healthcare management method involving the evaluation of patient kidney function, the method comprising:

defining a patient's medical record including the patient's demographic information, medical condition and diagnosis;

calculating the patient's estimated glomerular filtration rate based on the patient's medical record;

automatically generating at least one medical treatment recommendation based on the patient's medical record and estimated glomerular filtration rate; and

calculating at least one treatment goal for the patient.

Similar to the "patent-eligible" dependent claim of Abele, the patient's demographic information, medical condition and diagnosis defining the patient's medical record represent a "physical and tangible" object, i.e., the patient. The transformation of this data into at least one medical treatment recommendation is sufficient to render claim 10 (as well as claims 11-18) patent-eligible.

Applicants' Attorney requests that the Appeal be maintained.

Respectfully submitted,

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